REMARKS

Claims 77-86 and 109-148 are pending in the current application. Applicants have amended independent claims 77, 109, 119, 128, and 137. No new matter has been added. Reexamination and reconsideration of all claims, as amended, is respectfully requested.

§ 103

The Office Action rejected claims 77, 80-86, 109, 112-116, 119, 122-125, 128, 130-134, 137-139, and 141-146, including independent claims 77, 109, 119, 128, and 137 under 35 U.S.C. § 103 based on Bylsma, U.S. Patent No. 6,319,220 ("Bylsma") in view of Dotson, Jr., U.S. Patent No. 4,274,411 ("Dotson"). The Office Action rejected claims 78-79, 85-86, 110-111, 117-118, 120-121, 126-127, 129-131, 135-136, 140-141, and 147-148 based on Dotson in view of Bylsma, referencing Gonan, U.S. Patent 6,423,028 ("Gonan") for certain claimed ranges/values.

Applicants submit that the present design operates in a different manner than the Bylsma device, notably in that the present design provides selective operation – in particular, an ability to provide different timing schemes and may selectively deform and substantially close aspiration tubing according to an alterable and controllable nonrandom timing scheme. The Bylsma design, in contrast, shows a standard peristaltic pump having no discernable controllability. While the Bylsma design discusses altering fluid flow, such altered fluid flow is only discussed in the context of random variations thereof. No alterable and controllable timing scheme is offered in Bylsma.

Applicants again appreciate the guidance previously provided of the examiner suggesting "further clarification to *the pulse procedure* or structural elements that define the aspiration components." (Office Action mailed January 14, 2009, p. 6). Applicants have clarified the "selectively" portion of the claims relating to the pulse procedure, differentiating the claims from the pulse procedure of the Bylsma reference, by stating "wherein selectively deforming and substantially closing aspiration tubing occurs via the tubing deformation fluid control device in a controlled nonrandom manner such that fluid

is aspirated according to an alterable and controllable nonrandom timing scheme" (claim 109, with similar limitations in the other independent claims).

Bylsma discloses a device having a peristaltic pump 17, used to draw fluid through tubing 4 and apparently into receptacle 5. Nothing noteworthy about the peristaltic pump 17 is discussed, and thus it is assumed to be a standard peristaltic pump having a particular duty cycle. There is nothing in Bylsma that would suggest or disclose fluid aspirated according to an alterable and controllable nonrandom timing scheme as claimed.

The sole suggestion for altering fluid flow in Bylsma is the passage at col. 5, ll. 31-41, which discusses "random fluidics:"

> Likewise, the fluidics at or near the tip of the phacoemulsification needle *can be varied randomly*, alone or in combination with the random pulse mode. The *random fluidics* can be provided in various manners. For example, the speed of the peristaltic pump can be controlled so that the chive [sic] signal to the peristaltic pump is *randomly pulsed.* Alternatively, the flow through the irrigation and/or aspiration lines can be *controlled to vary in a random manner* (e.g. providing electrically controlled flow valves in irrigation and/or aspiration lines and/or vent(s) to irrigation and/or aspiration lines).

Emphasis added; see also, Bylsma claim 10(vii).

Random fluidics is not a part of the present design. The present design, in contrast, provides for a nonrandom alterable timing scheme, and a number of such timing schemes are discussed in the present specification, including but not limited to the passage at p. 20, l. 26, through p. 21, l. 23. Thus the random fluidics discussed in Bylsma do not disclose or suggest "fluid [aspirated] according to an alterable and controllable nonrandom timing scheme" as presently claimed.

Applicants submit that these amendments distinguish the claims from the disclosure of Bylsma and/or Dotson, and provide the recitation of timing sequence and the "selective" operation of fluid pulsing differentiates from the cited reference in a manner as suggested by the January 14 Office Action.

Dotson fails to make up for the deficiencies of Bylsma. Dotson shows a device employing a series of valves that do not deform tubing nor constitute a "tubing deformation fluid control device" as claimed. Dotson does not teach or suggest deformation of aspiration tubing as claimed, but instead keeps all illustrated tubing intact and undeformed. *See, e.g.* Dotson, col. 3, lines 30-39 and lines 48-50 and col. 5, lines 18-29. Dotson fails to disclose or suggest "selectively deforming and substantially closing aspiration tubing occurs via the tubing deformation fluid control device in a controlled nonrandom manner such that fluid is aspirated according to an alterable and controllable nonrandom timing scheme" as claimed.

Applicants therefore submit that Bylsma and/or Dotson fail to disclose a design that operates in the manner claimed, namely selectively deforming and substantially closing aspiration tubing occurs via the tubing deformation fluid control device in a controlled nonrandom manner such that fluid is aspirated according to an alterable and controllable nonrandom timing scheme. As a result of the amendments to independent claims 77, 109, 119, 128, and 137, these claims are allowable for the foregoing reasons, and all claims depending from allowable claims 77, 109, 119, 128, and 137 are also allowable as they include limitations not found in the cited references, alone or in combination.

Combination of References

Further, Applicants disagree that one of ordinary skill in the art would have a reason to combine the features disclosed in the Bylsma and Dotson references in the manner suggested in the Office Action. Dotson is solely relied on as purportedly showing inhibiting fluid flow and fails to teach or suggest deformation of tubing in the manner claimed. Bylsma is relied on for its peristaltic pump, which operates in a

different manner than recited in the amended claims. Applicants submit that a combination of Bylsma and Dotson is unreasonable, and such a combination uses hindsight to reconstruct the claimed invention. As noted, neither Dotson nor Bylsma selectively deform and substantially close aspiration tubing occurs via the tubing deformation fluid control device in a controlled nonrandom manner such that fluid is aspirated according to an alterable and controllable nonrandom timing scheme. Bylsma does not discuss aspiration according to an alterable and controllable nonrandom timing scheme, and thus would not be relied on to solve the problem currently solved by the present design, namely providing selective fluid flow into the region, in certain instances in addition to delivering ultrasonic energy.

The PTO has the burden of establishing a *prima facie* case of obviousness under 35 USC §103. The Patent Office must show that there is some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ___ (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075. In this case, the Examiner has not pointed to any cogent, supportable reason that would lead an artisan of ordinary skill in the art to come up with the claimed invention.

None of the references, alone or in combination, teach the unique features called for in the claims. It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.

> It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. [*citation omitted*]

In re Gordon, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

> To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a *prima facie* case for obviousness. *See, KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ___ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...," *citing In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," KSR at 14).

The reasoning supporting the combination is "to provide a system that aids in the aspiration of hard to remove pieces of material..." Office Action, p. 3. This is merely a conclusion used to justify choosing references based on aspects presented in the claims. It is always beneficial to improve operation, cost, efficiency, and so forth, but the question is what reasoning would have been used by one of skill to take the ultrasonic teachings of the Bylsma ultrasonic device and peristaltic pump and modify them in a manner consistent with the Dotson fluid valve design. Here, no such reason has been articulated. Conclusory reasoning such as that presented is improper hindsight reconstruction of the invention and for this further reason, claims 77, 109, 119, 128, and

137, as amended, and claims depending therefrom are allowable over the cited references.

Based upon the totality of the foregoing, Applicants respectfully submit that claims 77, 109, 119, 128, and 137, as amended, are allowable over the references of record, and all claims dependent therefrom are also allowable as they include limitations not present in the cited references.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims, as amended, are respectfully requested and allowance of all the claims at an early date is solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants believe that no fees are due in accordance with this Response. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account 502026.

Respectfully submitted,

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